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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,190	08/31/2001	Daniel M. Wing	1242.017	1208
7590	10/22/2003		EXAMINER	
John Pietrangelo Heslin Rothenberg Farley & Mesiti P.C. 5 Columbia Circle Albany, NY 12203			DESANTO, MATTHEW F	
		ART UNIT	PAPER NUMBER	
			3763	
DATE MAILED: 10/22/2003				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/944,190	WING ET AL.
	Examiner Matthew F DeSanto	Art Unit 3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 9,11-13,22,23,25-40,42-44,48-51,54 and 59-82 is/are pending in the application.
- 4a) Of the above claim(s) 27-30,32-40,42-44,50 and 51 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 9,11-13,22,23,25,26,31,48,49,54 and 59-82 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>18</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Objections

1. The Claim objection is withdrawn because of Applicants amendment and/or remarks.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 9-13, 31, 48, 49, 59 - 64, 75, 76, & 78-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al. (USPN 5290294).

Cox et al. disclosed a trocar assembly with a cannula (12) and an obturator (18) and a first and second bearing surface. (Figure 2). Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula.

As to claims 11-13, wherein the first or second bearing comprises an incline, and/or a boss and/or a linear and curvilinear surface. (Figure 2).

As to claims 48 and 49, wherein the first bearing surface is moveable relative to the cannula and the second bearing surface is moveable relative to the obturator. (Figure 2, and entire reference).

As to claims 59-61, 63, 64, 75 and 76 wherein the head assembly has a bearing surface, a fluid port with a valve.

4. Claims 9-13, 31, 48, 49, 54, 59-62, 65, & 78-82 rejected under 35 U.S.C. 102(b) as being anticipated by Scwemberger (USPN 5997510).

Scwemberger discloses trocar assembly with a cannula and an obturator and a first and second bearing surface. Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula as well as wherein the first or second bearing comprises an incline, and/or a boss and/or a linear and curvilinear surface, and wherein the first bearing surface is moveable relative to the cannula and the second bearing surface is moveable relative to the obturator, and wherein the head assembly has a bearing surface, a fluid port with a valve. (Entire reference)

5. Claims 9 – 13, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (USPN 4405307).

Taylor discloses trocar assembly with a cannula and an obturator and a first and second bearing surface. Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula as well as wherein the

first or second bearing comprises an incline, and/or a boss and/or a recess, and/or a linear and curvilinear surface. (Entire reference)

6. Claims 22-26, and 66-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (USPN 5807338).

Smith et al. discloses a trocar assembly with a cannula (112) and obturator (110),

As to claim 23, wherein the cannula is uniformly tapered from a second inside diameter, larger than the first inside diameter. (Figures 1, 14 and 18 and entire reference).

As to claim 24, wherein the first inside surface of the cannula is smooth and continuous. (Figures 1, 14 and 18 and entire reference).

As to claims 25, 26, wherein the obturator comprises a first tapered surface extending from the maximum diameter of the first end to the tip and a second tapered surface extending from the maximum diameter to the outside of the shaft. (Figure 2, 5, and 12 and entire reference).

As to claims 66-68, 70-71, and 73 wherein the head assembly has a bearing surface (Figure 2 and 16), a fluid port with a valve. (Figures 14 and 16 and entire reference).

As to claim 69 wherein the head assembly comprises a seal. Figure 14.

As to claim 72 wherein the cannula is non-metallic, column 5, lines 8-19.

7. Claims 22-23, 24, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Shipp (USPN 5,263,937).

Shipp discloses an obturator, a cannula, wherein the cannula has a flexible, smooth and continuous inside surface. (Figures 1-4, 7 and entire reference)

Response to Arguments

8. Applicant's arguments filed 3/3/03 have been fully considered but they are not persuasive.
9. Flom et al. is withdrawn for not having a pointed obturator end.
10. With regards to the Smith reference according to Figures 5 and 6 the outer diameter of the obturator has a knife blade that extends further out than the diameter of the obturator, therefore, when looking at figure 1, the diameter of the obturator (128) would be larger than the inner diameter of the cannula (116) because of the slits at the obturator to allow the knife to pass through. The applicant next argues that Smith does not teach a cannula that has an inside that is flexible, smooth and continuous. The examiner states that reference number 112 is a cannula. A cannula is a flexible tube according to (*The American Heritage® Dictionary of the English Language, Fourth Edition*. Copyright © 2000), and that is exactly what 112 is. Next the applicant states that the cannula is not flexible. This term is extremely broad, because everything has a certain degree of flexibility even on the microscope scale, so unless the applicant is more specific about the degree of flexibility this cannula has a certain degree of flex, thus making it flexible.
11. As to the Flom et al. reference the obturator is reference number 36 and the cannula is reference number 14. Therefore, the cannula and obturator have the locking

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means and the obturator has a bearing surface and is in contact with the cannula directly.

12. In response to applicant's argument that there is no "bearing surface" that causes axial and radial deflection is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). With regards to Cox, in Figure 2, the hooks (ref. 24) are going to be placed into grooves (ref. 22) and thus lock the obturator. The deflection is going to occur when the obturator's hooks are placed in the grooves of the cannula and rotated until the obturator is locked in place, thus by doing this in either direction the obturator is being displaced. (i.e. from the locked to unlocked or from the unlocked to the locked.) With regards to Schwemberger the pins and slots cause the same principles to occur, the obturator is going to move in an axially and/or radially direction when the "bearing surfaces" are deflected by the rotation of the obturator. The direction of the obturator is going to be dictated by the slot in reference number 92 because the pin has to move in accordance with the slot, and thus according to Figure 5, there has to be an axially and radially movement otherwise the slot and pin interaction would not lock the obturator and cannula.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.

Matthew DeSanto
Art Unit 3763
October 20, 2003

Brian Casler
BRIAN L. CASLER
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